

REMARKS

Claims 1 through 9 remain pending in this application and have been rejected in the Office Action dated October 20, 2004. In response to the Office Action, claims 2 and 7 have been amended. Care has been taken to avoid the introduction of new matter. Favorable reconsideration in light of the following comments is respectfully solicited.

Objection has been made to the specification, at paragraph 2 of the Office Action, and the drawings, at paragraph 3, for lack of description and illustration of two pairs of image pickup units, as recited in claim 7. Claim 7 has been rejected under the first paragraph of 35 U. S. C. § 112 for the lack of a supporting disclosure of two pairs of pickup units.

In response, claim 7 has been amended to recite that “a pair of said image pickup units and a pair of said pivot mechanisms are installed.” As recognized in the Office Action (paragraph 4), the disclosure, both the specification and Fig. 14, is enabling for the subject matter of claim 7 as amended. Withdrawal of the rejection, therefore, is respectfully solicited.

Claims 1 through 6, 8 and 9 have been rejected under 35 U. S. C. § 103(a) as being unpatentable over U.S. patent 6,177,950 (Robb) in view of U.S. patent 6,078,440 (Ueyama). Reconsideration and withdrawal of the rejection in light of the following comments are respectfully solicited.

Legal precedent is well developed with respect to 35 U.S.C. §103. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The PTO is thus charged with the initial burden of identifying a source in the applied prior art for: (1) claim features; and (2) the realistic requisite motivation for combining

applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). This burden is not met if there is no showing that the combination of references would actually meet all the limitations of the claims under consideration.

An Office Action rejection must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The examiner should recognize that even if the prior art *could* be modified so as to result in the combination defined by the claims the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). In the absence of such a prior art suggestion for modification of the references, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

What may or may not be known in general does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). The requisite motivation is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art, at the time the invention was made, to modify a reference in a specific manner to arrive at a specifically claimed invention with a reasonable expectation of achieving a specific benefit. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). It is

submitted that the prior art does not meet these criteria for any of the claims under rejection. The question is not what one having ordinary skill in the art could or could not do, but: *why* would one having ordinary skill in the art have been realistically impelled to deviate from the express teachings of the prior art to arrive at the claimed invention? *Gentry Gallery v. Berkline*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is submitted that the rationale stated in the Office Action for concluding obviousness is not sufficient to meet the above legal criteria. The Office Action recognizes that Robb does not teach the following requirement of independent claim 1:

a pivot mechanism for supporting said image pickup unit,
said image pickup unit being allowed to freely pivot centered on at
least two axes with respect to said main body.

The Ueyama disclosure of an image pickup unit that is supported by a pivot mechanism that allows the device to freely pivot while centered on at least two axes has been relied upon to conclude that it would have been obvious to “incorporate” the Ueyama pivot mechanism in the body of the Robb device “for automatic object chasing.”

The Office Action lacks description of how the examiner proposes to modify the Robb device to “incorporate” the Ueyama pivot mechanism. It is submitted that the proposed modification, rather than a mere substitution of parts, would encompass a substantial structural and functional reorganization of the Robb device. The Robb camera pickup and supporting structure is housed within a detachable clip on enclosure. The pickup may be pivoted to one of three positions that align with respective lenses. The Robb disclosure expresses no interest in “automatic object chasing.” The Office Action provides no rationale as to why a person of ordinary skill in the art would have been compelled to provide a sophisticated multi-axis tracking system, in which an image of a moving object is automatically maintained at the center of a display, in the portable

telephone of Robb, which has only three discreet camera positions. Although the Office Action is silent as to precisely how Robb is to be modified, it appears that such modification would destroy the operational functionality intended by the Robb teachings.

Dependent claims 3, 5, 8 and 9 all recite features that are not disclosed or taught by Robb and for which Ueyama has been additionally relied upon for concluding obviousness. Dependent claim 2 has been amended to require that the image pickup unit is non-detachably housed in said main body. No teaching of this feature is found in Robb. Robb discloses the pickup as being located within the removable clip-on enclosure 99.

Claim 7 has been rejected further under 35 U. S. C. § 103(a) as being unpatentable over Robb in view of Ueyama and U.S. patent 5,818,399 (Omori). The Office Action recognizes that neither Robb nor Ueyama discloses or teaches a pair of image pickup units, as understood in the Office Action as being required by claim 7. Omori has been relied upon for teaching stereoscopic pickups. Again, the Office Action is silent as to precisely how a combination of the teachings of these three references is to be implemented.

In summary, it is submitted that the Office Action has not established that a person of ordinary skill in the art would have been motivated to modify the express teachings of the prior art references to provide an implementation that has not been described in the Office Action in other than general functional terms. Improper hindsight considerations of the present disclosure cannot be a basis for providing specific structure of a purported obvious modification.

Accordingly, withdrawal of all objections and rejections and allowance are respectfully solicited. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, reading "Gene Z. Robinson". The signature is fluid and cursive, with a long horizontal stroke at the end.

Gene Z. Robinson
Registration No. 33,351

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 GZR:lnm:dmd
Facsimile: 202.756.8087
Date: January 18, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**